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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/684,330	10/09/2003	Yung Chang Liang	TRNDP009	9224

58766   7590   09/29/2008
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EXAMINER
GEE, JASON KAI YIN

ART UNIT	PAPER NUMBER
2134	

MAIL DATE	DELIVERY MODE
09/29/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *07/17/2008*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-15 and 17-22* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-15 and 17-22* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

1.   This action is response to communication: response to RCE received

07/17/2008, with arguments submitted on 09/19/2008.

2.   Claims 1-15 and 17-22 are currently pending in this application. Claims 1, 10,

and 17 are independent claims.

3.   No new IDS was received for this application.

4.   A request for continued examination under 37 CFR 1.114, including the fee set

forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this

application is eligible for continued examination under 37 CFR 1.114, and the fee set

forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action

has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on

07/17/2008 has been entered.

Response to Arguments

Applicant's arguments with respect to the claims have been considered but are

moot in view of the new ground(s) of rejection.

Terminal Disclaimer

5.   The terminal disclaimer filed on 04/16/2007 disclaiming the terminal portion of

any patent granted on this application which would extend beyond the expiration date of

the full statutory term defined in 35 U.S.C. §154 to §156, and § 173 of any patent

granted on Application No. 10/683,579, filed on October 9, 2007, has been reviewed

and is NOT accepted.

a. The person who signed the terminal disclaimer is not recognized as an officer ofthe assignee, and he/she has not been established as being authorized to act on behalf of the assignee. See MPEP § 324.

An attorney or agent, not of record, is not authorized to sign a terminal disclaimer in the capacity as an attorney or agent acting in a representative capacity as provided by 37 CFR 1.34 (a). See 37 CFR 1.321(b) and/or (c).

It would be acceptable for a person, other than a recognized officer, to sign a terminal disclaimer, provided the record for the application includes a statement that the person is empowered to sign terminal disclaimers and/or act on behalf of the organization.

Accordingly, a new terminal disclaimer which includes the above empowerment statement will be considered to be signed by an appropriate official of the assignee. A separately filed paper referencing the previously filed terminal disclaimer and containing a proper empowerment statement would also be acceptable.

It should be noted that applicant is not required to pay another disclaimer fee as set forth in 37 CFR 1.20(d) when submitting a replacement or supplemental terminal disclaimer.

Applicant's representative, specifically Rupak Nag (Agent Reg. No. 37493), is of record with the USPTO as an agent, and may not sign a terminal disclaimer. Accordingly, the terminal disclaimer is unacceptable and the double patenting rejection has not been overcome and is therefore maintained.

Double Patenting

6.   The nonstatutory double patenting rejection is based on a judicially created

doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the

unjustified or improper timewise extension of the "right to exclude" granted by a patent

and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-

type double patenting rejection is appropriate where the conflicting claims are not

identical, but at least one examined application claim is not patentably distinct from the

reference claim(s) because the examined application claim is either anticipated by, or

would have been obvious over, the reference claim(s). See, e.g., In re Berg, 140 F.3d

1428, 46 USPQ2d 1226 (Fed. Cir. 1998); In re Goodman, 11 F.3d 1046, 29 USPQ2d

2010 (Fed. Cir. 1993); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); In re

Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Vogel, 422 F.2d 438,

164 USPQ 619 (CCPA 1970); and In re Thorington, 418 F.2d 528, 163 USPQ 644

(CCPA 1969).

        A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d)

may be used to overcome an actual or provisional rejection based on a nonstatutory

double patenting ground provided the conflicting application or patent either is shown to

be commonly owned with this application, or claims an invention made as a result of

activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal

disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR

3.73(b).

7.   Claims 1 -15 and 17-22 are provisionally rejected on the ground of nonstatutory

obviousness-type double patenting as being unpatentable over claims 1 -33 of

copending Application No. 10683579 (hereinafter App. No '579). Although the conflicting

claims are not identical, they are not patentably distinct from each other because

Applicants' virus sensor operates in the same manner as the network virus/worm sensor

in the copending Application. Considering claim 1 of the instant Application, the "switch"

operation is later identified in claim 2 to be a function of the traffic controller whereas in

copending App. No. '579 the limitation of the switching of modes as facilitated by the

traffic controller is present in claim 1 along with the other functions of the network

virus/worm sensor.

        This is a provisional obviousness-type double patenting rejection because the

conflicting claims have not in fact been patented.

8.   Claims 1 -15 and 17-22 are provisionally rejected on the ground of nonstatutory

obviousness-type double patenting as being unpatentable over claims 1 -33 of

copending Application No. 10/683582 (hereinafter App. No '582). Although the

conflicting claims are not identical, they are not patentably distinct from each other

because Applicants' virus sensor operates in the same manner as the network

virus/worm sensor in the copending Application. Further, the monitors in both

applications registers itself automatically to the network. Further, both the inventions teach a controller which provides a The present application further includes a limitation of a controlelr which provides a rule set and an outbreak prevent policy. However, it is well known in the field of network security that controllers provides specific rule sets to apply throughout the network, so as to synchronize all the monitors in the system.

This is a <u>provisional</u> obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112

9.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10.   Claims 1-9, 15, and 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per claims 1-9, 15, and 22, the claims recite "such that the bandwidth of a network is substantially unaffected." The term "substantial" is a term of degree, and it is unclear what the metes and bounds are of the limitations.

As per claim 9, the claims recite "large selected files." The term "large" is an unclear amount, and it is unclear what the metes and bounds are of the limitations.

Claim Rejections - 35 USC § 103

11.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

12.   Claims 1-10, 13-15, 17, and 20-22 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Ramsey US Patent No. 7,331,061 (hereinafter Ramsey), in view of

Douglas et al. US Patent No. 6,269,400 (hereinafter Douglas), and further in view of

White et al. ("anatomy of a Commercial-Grade Immune System, IBM Research White

Paper, 1999) (hereinafter White).

        As per claim 1, Ramsey teaches in a distributed network of interconnected

computing devices, a network virus monitor, comprising: a virus sensor operable in a

number of modes arranged to detect a computer virus in the network such that the

bandwidth of the network is substantially unaffected in a first mode in that data packets

continue to their destination after they are copied creating copied data packets which

are analyzed for the computer virus (col. 12 lines 43-56; col. 13 lines 4-18; col. 15 lines

1-20; col. 16 lines 8-16; col. 18 line 17 to col. 19 line 34), and wherein when the virus

sensor detects the computer virus, the virus sensor switches to a second mode,

wherein original data packets are analyzed and a subset of data packets determined to

be infected or suspected of being infected are not returned to the network (col. 12 lines

43-56; col. 13 lines 4-18; col. 15 lines 1-20; col. 16 lines 8-16; col. 18 line 17 to col. 19

line 34), wherein the virus monitor receives a rule set (col. 12 liens 43-56; col. 16 lines 8-16; col. 18 line 17 to col. 19 line 34).

However, at the time of the invention, Ramsey does not teach all the limitations of the claims. These deficiencies are taught by Douglas though. Douglas teaches wherein the virus monitor is able to automatically collect network environment data and assign an IP address to itself, and wherein the virus monitor automatically locates a controller in the network and registers itself with the controller (col. 3 liens 28-49, and col. 4 lines 61-68).

However, at the time of the invention, the Ramsey combination does not explicitly teach a controller providing an outbreak prevention policy. However, this is taught by White, such as in Figure 3, pages 13 and 14).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to combine the Ramsey reference with the Douglas reference. One of ordinary skill in the art would have been motivated to conduct automatically discovery and registration of available agents on a distributed network because it requires low CPU utilization and requires minimal programming of the agents (Douglas, col. 2 lines 38-39).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to combine the White reference with the Ramsey combination. One of ordinary skill in the art would have been motivated to perform such an addition to provide an immune system that can find, analyze, and cure previously unknown viruses faster than the viruses themselves can spread (White, page 2, first pagaraph, lines 1-2.).

As per claim 2, Ramsey teaches wherein a traffic controller coupled to the virus sensor and the network arranged to select certain data packets wherein the selected data packets are forwarded to the virus sensor (col. 5 lines 35-48; col. 12 liens 43-56; col. 13 lines 4-20; col. 15 liens 1-18; col. 16 lines 8-15), and throughout the reference.

As per claim 3, Ramsey teaches wherein the traffic controller further comprises: a data packet copier operable in the first mode and arranged to generate a copied data packet of each of the selected data packets wherein the selected data packets are returned to the network (col. 13 lines 4-20)

As per claim 4, Ramsey teaches wherein the data packet copier is disabled in the second mode such that the selected data packets are passed to the virus sensor (Figure 5; col. 15 lines 5-18)

As per claim 5, Ramsey teaches a data packet protocol identifier coupled to the virus sensor arranged to identify a data packet protocol associated with the data packet infected by a computer virus (col. 4 lines 50-62; 10 lines 4-20).

As per claim 6, Ramsey teaches wherein the selected data packets are each associated with the data pcket protocol associated with the computer virus such that only those data packets associated with the identified data packet protocol are selected from the network (col. 4 lines 50-62; col. 10 lines 4-20).

As per claim 7, Ramsey teaches wherein the virus sensor unit further comprises a filescan module arranged to scan a selected file for the computer virus (col. 5 lines 55-66).

As per claim 8, Ramsey teaches wherein the filescan is remotely located (col. 6 liens 44-59).

As per claim 9, Ramsey teaches wherein the remotely located filescan is used for scanning large selected files (col. 6 lines 44-59).

Independent claim 10 is rejected using the same basis of arguments used to reject claim 1 above.

Claim 13 is rejected using the same basis of arguments used to reject claim 3 above.

Claim 14 is rejected using the same basis of arguments used to reject claims 5 and 6 above.

Claim 15 is rejected using the same basis of arguments used to reject claim 1 above.

Claim 17 is rejected using the same basis of arguments used to reject claim 1 above.

Claim 20 is rejected using the same basis of arguments used to reject claim 13 above.

Claim 21 is rejected using the same basis of arguments used to reject claim 13 and 14 above.

Claim 22 is rejected using the same basis of arguments used to reject claim 15 above.

13.   Claims 11, 12, 13, 18, and 19 are rejected under 35 U.S.C. 103(a) as being

unpatentable over the Ramsey combination as applied above, and further in view of

Hypponen et al. in US PGPub No. 2003/0191957 (hereinafter Hyponnen),

As per claim 11, the Ramsey combination does not explicitly teach all the

limitations of the claims. However, these are taught throughout Hyponnen. Hyponnen

teaches isolating a portion of the network infected by the computer virus; and Cleaning

the isolated portion of the network (paragraphs 15-18).

At the time of the invention, it would have been obvious to include the Hypponen

reference with the Ramsey combination. One of ordinary skill in the art would have

been motivated to perform such an addition to create more security without slowing

down the functions of the computer. (Hypponen paragraphs 4 and 5).

As per claim 12, Hypponen teaches sending a virus report to a controller

(paragraph 16-18)

As per claim 13, Hyponnen teaches copying selected ones of the flow of data

packets from

Claim 18 is rejected using the same basis of arguments used to reject claim 12

above. This is also taught throughout the Ramsey reference.

Claim 19 is rejected using the same basis of arguments used to reject claim 13

above.

Conclusion

14.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Jason K. Gee whose telephone number is (571) 272-

6431. The examiner can normally be reached on M-F, 7:00 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Kambiz Zand can be reached on (571) 272-3811. The fax phone number

for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

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Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

Jason Gee
Patent Examiner
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09/26/2008

/Kambiz Zand/

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